

Paper No. 40

CONRAD GARDNER
1502 N 97TH STREET
SEATTLE WA 98103

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In re Application of:
Gardner
Application No. 08/896,514
Filed: June 23, 1997
For: EXTENDED RANGE MOTOR VEHICLE
HAVING AMBIENT POLLUTION
PROCESSING
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OFFICE OF PETITIONS
ON PETITION

This is a decision on the petition filed September 7, 2004, which is being treated as a petition under 37 CFR 1.182 asking that the USPTO withdraw the terminal disclaimer filed July 3, 2000.

The petition is **dismissed**, but may be subject to favorable reconsideration upon prompt renewal as noted in more detail *infra*. This application will be retained in the Office of Petitions for a period of ONE MONTH, in which time petitioner should either renew the petition under 37 CFR 1.182 and submit the RCE (and fee), or advise the USPTO, in writing, that petitioner desires to continue with the current appeal. This period of time may **not** be extended under either 37 CFR 1.136(a) or § 1.136(b).

Petitioner renews his request for withdrawal of the aforementioned terminal disclaimer, which was approved and accepted by the USPTO on July 12, 2000.

The USPTO communication of August 3, 2004, noted that any renewed request for relief would have show consistency with the orderly examination process. The instant petition contends the request is consistent with an orderly examination process in that appellant's request for oral hearing before the Board of Patent Appeals and Interferences ("BPAI") would not be heard until November of 2004.

Petitioner has failed to advance any reasonable nexus between his request for extraordinary relief by way of withdrawal of the terminal disclaimer, and an oral hearing before the BPAI. Petitioner complains that the terminal disclaimer was proffered upon his expectation, after an interview with the then examiner of record, that a claim(s) amended to contain "cruise mode operation" and "hybrid vehicle" would be allowable if coupled with applicant's submission of a terminal disclaimer, and while petitioner contends that one or more of such claims is of record, none of these claims has been allowed. Inspection of the relevant Examiner's Interview Summary indicating that an interview occurred on November 2, 1998, also reveals that the examiner indicated (1)

agreement was not reached, (2) only claims 46 and 50 were discussed, and (3) the other claims would be subjected to an updated search. If, as petitioner contends, there are present herein one or more claims that contain both "cruise mode operation" and the "hybrid vehicle" limitations and further, the terminal disclaimer remains recorded, then the current appeal before the BPAI will determine the whether these claims are properly rejected *vel non*.

Petitioner appears to overlook that a terminal disclaimer can only overcome, or forestall, a rejection under the judicial doctrine of obviousness-type double patenting which rejection is necessarily predicated upon the claims of another application or patent in which the applicant is also the named inventor. Inspection of the rejections currently of record fails to reveal that any claim has been rejected on the grounds of obviousness-type double patenting over the claims found in any other application or patent in which petitioner is the named inventor. That is, the terminal disclaimer of which petitioner complains has no effect on the appealed rejections of record: indefiniteness under 35 U.S.C. § 112, second paragraph; anticipation under 35 U.S.C. § 102(b); and obviousness under 35 U.S.C. 103(a).

However, to favorably treat the request for withdrawal of the terminal disclaimer some four years after the initial close of prosecution and appeal would have the effect of now raising the question of the applicability of applicant's U.S. Patent No. 5,301,764 to one or more of the instant claims under appeal, under the judicial doctrine of obviousness-type double patenting. Petitioner has not shown, and inspection of the record fails to reveal, how raising the issue of obviousness-type double patenting, if the terminal disclaimer were now withdrawn, would be consistent with the orderly examination process. That is, two office actions on the merits mailed August 14, 2000, and April 2, 2001, and the appeal process initiated by the Notice of Appeal filed May 8, 2001, culminating in the acceptable Brief on Appeal filed December 3, 2003, the Examiner's Answer of March 3, 2004, and the Reply Brief filed May 3, 2004 and considered by the examiner on July 21, 2004, were all generated with the recorded terminal disclaimer mooting the need for consideration of the question of obviousness-type double patenting. To now raise the issue of obviousness-type double patenting would not be consistent with the orderly examination process, especially in light of petitioner's delay in seeking withdrawal of the terminal disclaimer until prosecution had advanced to the late stage of the instant appeal.

Nevertheless, 37 CFR 1.182 notes that relief may be granted under the regulation "subject to such other requirements as may be imposed." Under the circumstances of this case, the filing of an RCE under 37 CFR 1.114 (and fee) will be imposed as a requirement of favorably considering petitioner's renewed request to withdraw the recorded terminal disclaimer. The successful request for withdrawal of the recorded terminal disclaimer, in this case, will be considered to fulfill the requirement of 37 CFR 1.114(c) for a submission. Of course, if petitioner renews the petition under 37 CFR 1.182 and files the RCE (and fee), then upon favorable treatment of the renewed petition the RCE will be treated as a request to withdraw the appeal and to reopen prosecution of this application before the examiner. See 37 CFR 1.114(d).

If petitioner wishes to continue with the current appeal, then the petition under 37 CFR 1.182 should not be renewed and the RCE should not be filed in reply to this decision. Rather, petitioner should advise the USPTO, in writing, that he wishes to continue with the current appeal. In this instance, however, the terminal disclaimer will not be withdrawn and will remain in full force and effect.

As noted above, this application will be retained in the Office of Petitions for a period of ONE MONTH, in which time petitioner should either renew the petition under 37 CFR 1.182 and submit the RCE (and fee), or advise the USPTO, in writing, that petitioner desires to continue with the current appeal. This period of time may **not** be extended under either 37 CFR 1.136(a) or § 1.136(b). At the end of this period, plus reasonable mail room time, if petitioner has not further replied, this application will be returned to the BPAI.

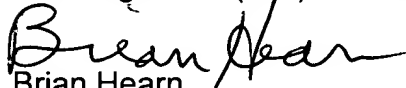
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Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
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